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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,594	09/28/2004	Casey Douglas Parks	040801	5593
35501	7590	04/10/2006	EXAMINER	
LAFKAS PATENT LLC 7811 LAUREL AVENUE CINCINNATI, OH 45243			WONG, STEVEN B	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 04/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/711,594	<b>Applicant(s)</b> PARKS ET AL.	
	<b>Examiner</b> Steven Wong	<b>Art Unit</b> 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2006.  
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 16-19 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1-13 and 16-19 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 112***

1. The amendments to the claims have overcome the rejections under 35 U.S.C. 112.

***Claim Rejections - 35 USC § 103***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-7 and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knez (D369,845) in view of Fariest (D181,633). Note the basis for the rejections set forth in the Office Action mailed November 10, 2005. Regarding the added limitation to claim 1, it would have been obvious to one of ordinary skill in the art to provide the same number of support holes as number of bristle packets in order to properly support the bristle packets. Further, the amendment to require three or four bristle packets is considered to be obvious to one of ordinary skill in the art given the teachings of Fariest and the lack of a showing of the criticality for the particular number by a new and unexpected result obtained therefrom.
4. Claims 8, 13 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knez (D369,845) in view of Fariest (D181,633) and Ranseen (1,670,123). Note the basis for the rejections set forth in the Office Action mailed November 10, 2005.

***Response to Arguments***

5. Applicant's arguments filed February 7, 2006 have been considered but are not persuasive. The applicant argues that the instant invention is a golf tee cap that fits a standard tee. The applicant contends that the inventions of Knez and Fariest are golf tees themselves. However, this argument is not persuasive as instant claims 1-7, 9-12, 14 and 15 fail to define the golf tee in association with the golf tee cap. The preamble of the claims only defines a golf tee

Art Unit: 3711

cap, however, it fails to associate this cap with the golf tee whatsoever. Clearly, the invention of Knez could be termed a golf tee cap that is merely placed on the ground. The limitation cap is not seen as necessarily requiring the connection or attachment thereof to a golf tee as applicant appear to purport.

Further, the limitation for the “cap” appears in the preamble of the apparatus claims. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Regarding the particular number of bristle packets, it would have been obvious to one of ordinary skill in the art to have three or four bristle packets for the tee of Knez as modified by Fariest as the applicant has not shown the criticality for the particular number of packets by a showing of a new and unexpected result obtained therefrom and it appears that the number of packets taught by Fariest would accomplish similar results. The applicant's argument that the three or four bristle packets limits the friction between the ball and the bristles does not sufficiently define a criticality for the particular number of packets because there is no associated criticality that is obtained solely with the claimed number of packets. See *In re Aller* 105 USPQ 233.

Regarding the combination of Knez in view of Fariest and Ranseen, the applicant argues that the Ranseen fails to teach a golf tee cap having support holes in teh circular base and three or four bristle packets within the holes. The applicant further states that a golf ball teed on the

Art Unit: 3711

collar of Ranseen would be placed on the top portion of the tee and therefore, increased frictional contact would still be created over the tee cap of the instant invention.

However, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Here, the combination is over the references to Knez in view of Fariest and Ranseen. The reference to Ranseen is relied upon merely for its teaching that it is well known in the art of golf tees to form a golf tee cap for the tee for supporting the golf ball. Regarding the applicant's argument that the tee would still support the golf ball, attention is directed to Figure 5 showing a golf ball that solely lies on the golf tee cap. It would have been obvious to one of ordinary skill in the art to manufacture the member of Knez to a size that is capable of receiving a golf tee within the core in order to firmly secure the member in the ground and limit its travel should it be impacted by a golf club head.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37


Art Unit: 3711

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 571-272-4416. The examiner can normally be reached on Monday through Wednesday 7am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Steven Wong  
Primary Examiner  
Art Unit 3711

SBW  
March 27, 2006